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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,324	12/02/2003	Karl L. Ginter	7451.0005-04	6224
22852	7590	05/27/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER SHAN, APRIL YING	
			ART UNIT 2435	PAPER NUMBER
			MAIL DATE 05/27/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/727,324

Applicant(s)

GINTER ET AL.

Examiner

APRIL Y. SHAN

Art Unit

2435

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-59, 62 and 63 is/are pending in the application.
- 4a) Of the above claim(s) 42-59, 62 and 63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 21-59 and 62-63 have been presented for examination. Claims 1-20 and 60-61 have been canceled. Claims 42-59 and 62-63 have been withdrawn from consideration. Thus, claims 21-41 have been examined.
2. Any objection/rejection not repeated below is withdrawn due to applicant's argument/explanation/amendment.

Continued Examination Under 37 CFR 1.114

3. A Request for Continued Examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2 March 2009 has been entered.

Priority

4. Acknowledgment is made that the instant application is a continuation of Application No. 08/699,712, filed 08/12/1996, now abandoned, which is a continuation-in-part of Application No. 08/388,107, filed 02/13/1995, now abandoned.

Response to Arguments

5. Applicant's arguments have been fully considered, but are moot in view of the new ground(s) of rejection as set forth below.

Claim Interpretation

6. In claim 21, "if the user is determined by said determining step to be authorized to access the online service, issuing a second digital certificate to the user, the second digital certificate attesting to the user's permission to access the online service" is being recited.

It appears to the examiner this "if" clause is optional and the step of "issuing a second digital certificate to the user, the second digital certificate attesting to the user's permission to access the online service" does not have to be performed if the user is determined by said determining step **not** to be authorized to access the online service. In order to further exam on the merits of the claim, the examiner assumes issuing a second digital certificate to the user, the second digital certificate attesting to the user's permission to access the online service is not an optional step.

Claim Objections

7. Claims 21-41 are objected to because of the following informalities:

In claim 21, "if the user is determined by said determining step to be authorized to access the online service, issuing a second digital certificate to the user, the second digital certificate attesting to the user's permission to access the online service" is being recited. It appears to the examiner this if clause is optional and the step of "issuing a second digital certificate to the user, the second digital certificate attesting to the user's permission to access the online service" does not have to be performed if the user is determined by said determining step **not** to be authorized to access the online service. In order to further exam on the merits of the claim, the examiner assumes issuing a second digital certificate to the user, the second digital

certificate attesting to the user's permission to access the online service is not an optional step.

Any claim not specifically addressed, above, is being objected as incorporating the deficiencies of a claim upon which it depends.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 21-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 21-41 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claim is neither positively tied to a particular machine that accomplishes the claimed method steps nor transforms underlying subject matter, and therefore do not qualify as a statutory process. The claimed method including steps of receiving a first digital certificate from a user, determining whether the user is authorized to access the online service and issuing a second digital certificate to the user are broad enough that the claim could be completely performed manually, mentally, verbally or without a machine

nor is any transformation apparent. For example, one can receive a first digital certificate from a user, one can determine whether the user is authorized to access the online service and one can issuing a second digital certificate to the user. The claims do not require the medium to accomplish the claimed method steps and therefore does not define a statutory process.

Please note any amendment should be commensurate with its corresponding original disclosure.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 21-23, 26-27, 29, 32-33 and 36-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Sudia (U.S. Patent No. 5,659,616).

As per **claim 21**, Sudia discloses a method for providing access to an online service ("...electronic commerce business" – e.g. col. 4, lines 52-53), the method comprising:

receiving a first digital certificate from a user, the first digital certificate attesting to at least one attribute of the user ("receiving a digital identifying certificate issued by a certifying authority and have a plurality of digital fields, at least one of said fields identifying said user" – e.g. claim 1);

determining, based at least in part on the first digital certificate, whether the user is authorized to access the online service ("When a recipient user (verifier) receives a transaction 51 from a sending user, the recipient first uses the sender's basic key certificate 55 to verify the sender's signature 52 on the transaction..." – e.g. col. 9, lines 36-40);

issuing a second digital certificate to the user, the second digital certificate attesting to the user's permission to access the online service ("receiving a digital authorization certificate, separate from said identifying certificate and issued by a sponsor of said user, and authorizing transactions by said user..." - e.g. claim 1, "...the recipient also uses the sender's authorization certificate 56, signed by the sender's sponsor 59, to verify..." – e.g. col. 9, lines 36-45).

Please note further in col. 14, lines 5-18, Sudia also discloses "...it may often be helpful to the copy the user's public key out of his basic authentication certificate and include it as another attribute in an authorization certificate. This permits the authorization certificate to serve both purposes (authentication and authorization) and allows the sender to omit the basic authentication certificate from each transaction". It is clear that in the Sudia reference, the authentication and authorization certificates are either two separate certificates or one authorization certificate to serve both authentication and authorization purposes.

As per **claims 22-23**, Sudia further discloses receiving a request from the

user to access the online service (“...electronic commerce business” – e.g. col. 4, lines 52-53); checking the second digital certificate to determine whether the user has permission to access the online service (“verifying said transaction based on information in said identifying certificate and in said authorization certificate, said step of verifying including applying said rules...to verify...” - e.g. claim 1); and allowing the user to access the online service if it is determined that the user has permission to access the online service (“accepting said transaction based on said outcome of said verifying...” - e.g. claim 1) and in which said checking step is performed in a protected processing environment at a local computer system from which the user made the request to access the online service (“a system for securely using digital signatures in a commercial cryptographic system...” – e.g. abstract).

As per **claims 26-27**, Sudia further discloses providing a third digital certificate to the user, the third digital certificate attesting to the identify of the online service, the third digital certificate being issued by a certifying authority (e.g. col. 3, lines 48-67, col. 4, lines 10-38) and in which the first digital certificate is issued by the certifying authority (“receiving a digital identifying certificate issued by a certifying authority and have a plurality of digital fields, at least one of said fields identifying said user” – e.g. claim 1).

As per **claim 29**, Sudia further discloses in which the first digital certificate identifies a party responsible for paying for the user’s access to online services (identifying said user – e.g. claim 1 and “user name” of user basic certificate of

fig. 5)

As per **claim 32**, Sudia further discloses in which the second digital certificate attests to the user's permission to access the online service until a specified date ("Certificates also contain an expiration date..." – e.g. col. 4, lines 1-9).

As per **claim 33**, Sudia further discloses in which the at least one attribute comprises an indication of the amount of purchases the user is allowed to make in a given time period (e.g. col. 11, lines 11-41).

As per **claims 36-37**, Sudia further discloses in which the online service comprises a subscription ("...into the attribute certificates of the CA and its subscribers.." – e.g. col. 7, lines 37-38) and in which the second digital certificate includes an expiration date of the subscription ("Certificates also contain an expiration date..." – e.g. col. 4, lines 1-9).

As per **claims 38-39**, Sudia further discloses collecting payment information from the user (e.g. col. 12, lines 1-18) and further comprising: sending the payment information to a financial clearinghouse (e.g. col. 6, lines 1-15 and col. 12, lines 1-18).

As per **claims 40-41**, Sudia further discloses collecting information relating to the user's use of the online service (col. 12, lines 1-18) and further comprising sending the

information relating to the user's use of the online service to a usage clearinghouse (e.g. col. 6, lines 1-15 and col. 12, lines 1-18).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) and in view of Arnold (U.S. Patent No. 5,956,408)

As per **claims 24-25**, Sudia does not expressly disclose sending software to the user. However, this well known feature is disclosed in col. 1, lines 10-14 of Arnold reference. It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Arnold's sending software to the user with Sudia since sending software to the user assures security (e.g. Arnold, col. 5, lines 1-14).

Arnold further discloses sending a digital signature for determining the integrity of the software to the user (Arnold, e.g. abstract) and in which the digital signature is bound, at least in part, to the identity of the online service (Arnold, e.g. abstract).

15. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) and further in view of Boulton et al. (U.S. Patent No. 5,537,618)

As per **claim 28**, Sudia discloses a digital identifying certificate issued by a certifying authority and having a plurality of digital fields, at least one of said fields identifying said user (Sudia, e.g. claim 1).

Sudia does not expressly disclose in which the first digital certificate includes an indication of the user's age.

However, it is well known at the time of the invention age is an attribute to identify a user. This well known feature is disclosed in col. 37, lines 32-34 of the Boulton et al. reference.

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Boulton et al.'s age is an attribute to identify a user into Sudia since a user's age is one of the attributes that identifying the user.

16. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) and in view of Doggett et al. (U.S. Patent No. 5,677,955)

As per **claim 30**, Sudia does not explicitly disclose sending a request for payment to the party responsible for paying for the user's access to online services and receiving an indication that payment has been received.

However, Doggett et al. met the claimed limitation by disclosing *the payer 12 receives a bill or invoice from the payee and the payer's bank, in turn, transfers funds to the payee's account at the payee's bank, which sends a record of the transaction to the payee with accounts receivable information* (e.g. par. 17, lines 30-57).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Doggett et al.'s sending a request for payment to the party responsible for paying for the user's access to online services and receiving an indication that payment has been received into Sudia in order to collect payment of the transaction.

This combination would predictably result a well known collect payment for a service. It has been held that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does not more than yield predictable results." *KSR.*, 127 S. Ct. at 1739, 82USPQ2d at 1395 (2007) (citing *Graham*, 383 U.S. at 12).

17. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) and in view of Doggett et al. (U.S. Patent No. 5,677,955) and further in view of Gifford (U.S. Patent No. 5,724,424).

As per **claim 31**, Sudia - Doggett et al. does not explicitly disclose steps in which the steps of (a) sending a request for payment and (b) receiving an indication that

payment has been received are performed prior to performing the step of sending the second digital certificate to the user.

However, Gifford met the claimed limitation by disclosing *a network payment service is used to authorize the purchase before merchant fulfillment is performed* (e.g. col. 3, lines 24-26. Please note merchant fulfillment is performed corresponds to Applicant's sending the second digital certificate to the user).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Gifford's the steps of (a) sending a request for payment and (b) receiving an indication that payment has been received are performed prior to performing the step of sending the second digital certificate to the user into Sudia in order to pay before accessing service.

This combination would predictably result a well known collect payment before accessing service. It has been held that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does not more than yield predictable results." *KSR*, 127 S. Ct. at 1739, 82USPQ2d at 1395 (2007) (citing *Graham*, 383 U.S. at 12).

18. Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia (U.S. Patent No. 5,659,616) and further in view of Rebane et al. (U.S. Patent No. 5,978,567)

As per **claims 34-35**, Sudia does not expressly disclose in which the online service comprises an interactive online game.

However, this well known feature is disclosed in the abstract, col. 1, lines 48-64, col. 3, lines 22-31 and col. 8, line 66 – col. 9, line 12. It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Rebane et al.'s the online service comprises an interactive online game into Sudia since online service comprises an interactive online game is offered electronically and interactively is well known in the art. (e.g. Rebane et al., col. 1, lines 48-64).

Sudia-Rebane et al. further discloses sending software for playing the online game to the user in a secure container (Sudia, - e.g. abstract and Rebane et al. - e.g. col. 9, lines 37-52).

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO -892)

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/
Examiner, Art Unit 2435